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PROCOPIO, CORY, HARGREAVES & SAVITCH LLP
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EXAMINER

MURDOUGH, JOSHUA A

ART UNIT	PAPER NUMBER
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3621

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/686,955	Applicant(s) SINGER ET AL.	
	Examiner JOSHUA MURDOUGH	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 49 is/are pending in the application.
- 4a) Of the above claim(s) 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/18/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination (“RCE”) under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. §1.114. Applicant's submission filed on 21 January 2009 has been entered.

Acknowledgements

2. This action is responsive to the above noted RCE and the amendments associated therewith.
3. This action has been assigned paper number 20090401 for reference purposes only.
4. Claims 1-20 and 39 are pending.
5. Claim 39 is withdrawn.
6. Claims 1-20 have been examined.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-10 and 13-20 are rejected under 35 U.S.C. §102(e) as being anticipated by

Chase JR (2003/0187801) hereafter "Chase."

7. As to claim 1, Chase shows:

- a. A method of binding content to a hub network, comprising:
- b. receiving a request to bind a discrete version of content (Figure 1, element 12) to a hub network (Figure 1, element 10), including a server (Figure 1, element 24) and a client (Figure 1, element 14) as members of said hub network (the user requests a license [0018] that binds the discrete content and the license to a "black box" [0017]. Therefore, the request is also a request to bind the content.),
- c. wherein said discrete version includes discrete locked content data [0016], and wherein said content data is stored on said server ("content server," Figure 1, element 24);
- d. disabling said discrete version (encrypting it would make it disabled until the correct key is applied) and enabling a bound instance to bind said content to said hub network at the server (The license 16 created by the license server 24 restricts the user to rendering in compliance with the license [0110]. Therefore, the conditions the black box enforces are set at the server.) ;
- e. creating a source version **12p** (the server 22 is the distribution source [0118] , therefore the version on the server would be the source version) of said content stored on

said server, wherein said source version includes source locked content data [0011]
[0083]; and

f. creating a root license stored on said server (since the license is encrypted with the private root key, it is understood to be a root license [0213]),

g. wherein said root license is bound to said hub network (the private root key is unique to the server [0213], therefore the license cannot be read outside of the network).

8. Chase does not show in Figure 1 that the licensing server, content server, and black box server are a single server. However in paragraph [0107], Chase states “in one embodiment of the present invention the license server 24, the authoring tool 18, and/or the content server 22 may reside on a single computer, processor, or other computing machine together with the black box server 26, each in a separate work space.”

9. As to claim 2, Chase further shows:

h. receiving said discrete version stored on compliant media [0080];

i. wherein compliant media is readable and writable electronic storage media [0080].

10. As to claim 3, chase further shows:

said discrete version has a corresponding discrete license (Figure 8, element 16).

11. As to claim 4, Chase further shows:

disabling said discrete version includes disabling said discrete license (Abstract).

12. As to claim 5, Chase further shows:

creating said root license includes creating said root license according to said discrete license [0214]-[0220].

13. As to claim 6, Chase further shows:

said server will decrypt said discrete locked content data after disabling said discrete version upon request [0016].

14. As to claim 7, Chase further shows:

said root license indicates said server has root responsibility for said source version (Through the root license, the root server delegates its authority to other servers [0221]).

15. As to claim 8, Chase further shows:

j. creating a copy of said discrete locked content data [0080]; and

k. storing said copy as said source locked content data [0080].

16. As to claim 9, Chase further shows:

l. creating bound licensing authority data according to discrete licensing authority data [0221];

m. wherein said discrete licensing authority data corresponds to said discrete version (Figure 1, element 12p) and said discrete licensing authority data indicates an external server is an external licensing authority (Figure 1, element 24), said bound licensing authority data corresponds to said source version and said bound licensing authority data indicates said root license is a local licensing authority and said external server is an external licensing authority [0221].

17. As to claim 10, chase further shows:

said discrete version has a corresponding revocation list of one or more revoked devices wherein a revoked device is a device with an authorization to participate in a hub network has been revoked [0159].

18. As to claim 13 Chase further shows:

creating a revocation list corresponding to said source version by creating a copy of said revocation list corresponding to said discrete version (as the revocation list is part of the license, and the license terms are distributed with the content [0212] the list is contained in the source version).

19. As to claim 14, Chase further shows:

said server and said client are both compliant devices, a compliant device will not decrypt locked content data without a license that is bound to a hub network of

which the compliant device is a member (This is inherently true, as the content is locked/encrypted by a key that binds it to the DRM system. [0017]-[0018]).

20. As to claim 15, Chase further shows:

a compliant device that is not a member of said hub network will only decrypt said discrete locked content data upon request while said discrete version is not disabled (the license can be disabled, thus a compliant device detecting a disabled license would not be able to retrieve the content key, and thus not be able to decrypt the content [0020]).

21. As to claim 16, Chase further shows:

- n. creating a source key by copying a discrete key (same key for both, therefore it must have been copied [0212]);
- o. wherein said discrete key is for decrypting said discrete locked content data, and said source key is for decrypting said source locked content data [212].

22. As to claim 17, Chase further shows:

said discrete locked content data is encrypted using a content encryption technique, said source locked content data is encrypted using said content encryption technique, said discrete key is encrypted using a hub network encryption technique that is different from said content encryption technique, and said source key is encrypted using said hub network encryption technique [0011].

23. As to claim 18, Chase further shows:

said server stores a hub network key for decrypting data encrypted using said hub network encryption technique [0012]-[0013].

24. As to claim 19, Chase further shows:

said hub network encryption technique is different from said content encryption technique because said hub network encryption technique uses a different key for encrypting data than the key that said content encryption technique uses for encrypting data [0011].

25. As to claim 20, Chase further shows:

said root license is encrypted using said hub network encryption technique [0213].

26. Claims 11 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chase.

27. As to claim 11, Chase discloses as discussed above in regards to claim 10.

28. Chase further shows a check for the revocation of user's license [0306].

29. Chase does not show the check being performed prior to accepting content to the server.

However, the steps would be the same as those performed for the user. Therefore, it would have

been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Chase to include the check prior to allowing content to be uploaded in order to prevent the repeated uploading of content with viruses to the server.

30. As to claim 12, Chase discloses as discussed above in regards to claim 10.

31. Chase further shows the updating of the revocation list [308] and a check for the revocation of user's license [0306].

32. Chase does not show these concepts in relation to the server. However, the steps would be the same as those performed for the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Chase to include the check prior to allowing content to be uploaded in order to prevent the repeated uploading of content with viruses to the server.

Definitions

33. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.¹ Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

¹ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

Network: “A group of computers and associated devices that are connected by communications facilities. A network can involve permanent connections, such as cables, or temporary connections made through telephone or other communication links. A network can be as small as a local area network consisting of a few computers, printers, and other devices, or it can consist of many small and large computers distributed over a cast geographic area.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

Response to Arguments

34. Applicant's arguments filed 21 January 2009 have been fully considered but they are not persuasive.

35. Applicants argue:

36. “As explained above, a hub network includes a server and a client as members of the hub network. While multiple server devices can be members in the same hub network, only one server device acts as the server for the hub network and the additional server devices act as clients of the hub network's server.

37. As shown in Figure 1 of Chase and described in Paragraphs [0081] and [0100] of Chase, multiple servers interact with the user's computing device 14 as servers. Thus, a hub network, as described and claimed by Applicants, is not taught by Chase” (Remarks, Page 11, Paragraphs 1-2).

38. Examiner's response:

39. The Examiner first notes the use of the word "includes" in the first line of Applicants' argument. Includes is open ended in much the same way "comprising," which is used in the claims, is open ended. Neither of the terms prohibits other elements from being present.

40. The argument that “only one server device acts as the server for the hub network and the additional server devices act as clients of the hub network's server” is not claimed. It is not proper to read limitations from the specification into the claims except when lexicography is present or 35 U.S.C. 112 6th paragraph is invoked. It is the Examiner's conclusion that neither of these special situations is present.

41. The Examiner notes that claims 1-20 are method claims. Consequentially, the structures recited are not material to patentability unless “the recited structural limitations therein...affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure” (*Ex parte Pfeiffer*, 135 USPQ 31, 33, (Brd. Pat. App. & Int. 1961)). As the method steps are shown as being performed substantially as claimed, with the difference being the component performing the steps, the Examiner's position is that the server configuration is not sufficient to establish patentability. The Examiner, however, has rejected the claim under 103 in case a reviewing body disagrees with this interpretation.

42. Applicants argue:

43. “The Examiner's reliance on Chase to teach a hub network is misplaced as Figure 1, element 10 of Chase refers broadly to an enforcement architecture as described in Paragraph [0040] of Chase. There is no teaching of a hub network that allows a user to obtain instances of

content and bind the instances in the hub networks of the user's home media network environment as described in Paragraph [0054] of the Applicants' Publication" (Remarks, Page 12, Paragraph 1).

44. Examiner's response:

45. The architecture of the system is a network. Figure 1 clearly discloses a client (14), multiple servers (22, 24, and 26) which communicate with each other (see arrows) in order to transfer content (12p), licenses (16), and keys (PU-BB and PR-BB) which are used to bind the content to the network. See also [0047].

46. Applicants argue:

47. "From the above passages it is clear that the black box 30 the Examiner is referring to is installed on the user's computing device 14. Therefore, should any binding be performed by Chase, it is performed at the user's computing device 14 and not at a server, as recited in claim 1" (Remarks, Page 16, Paragraph 1).

48. Examiner's response:

49. The enforcement of the binding is performed by the black box. However, the licensing server 24 sets forth the conditions that must be complied with. Thus, the license server is actually the party performing the binding in much the same way as was disclosed in the cited passage. In particular [0033] describes the issuing and management of licenses for the content data of the bound instance.

50. Applicants argue:

51. “Additionally the description of a third server (black box server 26) performing server functions further illustrates that Chase does not teach or suggest a hub network as set forth in limitation (a) of claim 1.

52. Examiner's response:

53. Again the Examiner directs Applicants' attention to [0107].

Conclusion

54. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

55. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

56. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621